

Docket No.: 65043-0038

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Dated: December 2, 2003

Signature: 

(Wendy Balaban)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of:
John M. Shanahan

Application No.: 09/888,145

Group Art Unit: 3711

Filed: June 22, 2001

Examiner: V. Mendiratta

For: A CARD GAME WITH PREDETERMINED
HANDS IN A FORTUNE COOKIE

REPLY BRIEF

Mail Stop AF
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a Reply Brief under Rule 193 in response to the Examiner's Answer dated October 2, 2003.

Claims 1, 3-6, 8, 10, 11, 13 and 14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller and Claims 2, 7, 9 and 12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller in view of Reynolds. In the Examiner's answer dated October 2, 2003, the Examiner stated his position as:

(1) The Mueller system is merely a game of chance, which is the same as the invention disclosed by Appellant;

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(2) The Muller system is only different by the information conveyed by the printed material; and

(3) Predetermining suits and denominations pertains to rules and does not add any further limitations to the apparatus in the claim.

To fully appreciate the merits of Appellant's argument, a discussion of Mueller is warranted. Mueller generally discloses a prepackaged set of fortune cookies that are sold as a set which are not usable with cookies of another set. For example, Mueller discloses a set of fortune cookies, wherein each cookie has a paper "containing information which is interrelated with information on the other papers contained in the cookies." Column 2, lines 8-15. Further, Mueller states at column 2, lines 15-18, "the fortune cookies of a given game comprise a set, and require packaging by sets, rather than random selection." Column 2, lines 22-23, states that the written composition "must be arranged in a specified order, to re-create the composition or story." To determine whether the players get the right combined composition, "a key... is included in the game." Column 2, lines 33-34.

As will be readily understood, the invention disclosed in Mueller specifically recites a game in which the papers contained within a specific set of cookies are only usable with papers of another cookie from the set. Each paper is specifically chosen, such that it interrelates with the other papers in the cookies of the set. Thus, the papers in the cookies from one set cannot be used with the papers of cookies from another set. This predetermined set of cookies is also packaged with an answer key that provides a solution

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to the set. As can be seen, the invention disclosed by Mueller is more akin to a board game in which the contents to be used are packaged in a box, sold to a consumer and used as a set. Further extending this metaphor, one cannot use the components of one board game with the components of a completely different board game.

Such an approach as the one described above is not conducive to restaurants or other locations that commonly use fortune cookies. These restaurants randomly distribute fortune cookies at the end of meals and do not provide each table with a "set" of cookies. Instead, as is commonly done, any individual person may receive any random fortune cookie which, most likely, has no relationship with any other cookie. Thus, if the set of cookies provided by Mueller were to be used in the restaurant industry, the industry would be forced to undergo the expensive and highly difficult task of distributing sets of cookies to each table, instead of randomly providing cookies as is conventionally done in the industry.

The present invention overcomes the drawbacks in the cited art by providing a fortune cookie game in which random cookies may be used in conjunction with other random cookies. Here, the cookies do not need to be provided in sets. The claims of the present invention reflect this novelty by reciting that "at least two separate hands are used." The claimed invention does not limit its scope to specific sets. Each card game of any cookie may be used against any other of an infinite number of card games for an infinite number of fortune cookie. The claimed invention further recites this novel feature by reciting that the game involves card hands. Card hands do not require

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predetermined other hands to be provided in order for the game to work. By this way, the present invention provides a fortune cookie game that does not rely on prepackaged cookies, answer keys, or any other system that relies on prepackaging the cookies. This provides a game that is much more usable by the restaurant industry.

With regard to the Examiners answer, assuming *arguendo* that both Mueller and the present invention only differ in being different games of chance, the "game of chance" disclosed by Appellant's invention, allows Appellant's system to be used by any number of people, and does not limit the usage of the game to being used in sets. Additionally, as stated in Appellant's opening brief, the Examiners citation to *Ex Parte Breslow*, 192 USPQ 431 is simply misplaced. This case does not stand for the proposition that mere differences in meaning and information do not provide patently distinguishable features. More importantly, however, is that the present invention differs from the cited art by more than merely the written information on the papers. Instead, the present invention provides a completely different game structure, as well as a different number of papers (at least two instead of a predetermined set), which allow it to overcome the drawbacks of the conventional art by not limiting the fortune cookie games to sets. Lastly, the Examiner's position, cited without any authority, that predetermining suits and denominations do not provide any patentably limiting features is equally misplaced for the exact same reasons set forth above.

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In view of the foregoing, it is submitted that the final rejection of claims 1-14 is improper and should not be sustained. Therefore, a reversal of the Final Rejection of April 28, 2000 (Paper No. 27) is respectfully requested.

Dated: December 2, 2003

Respectfully submitted,

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